

### **REMARKS**

Claims 1-27 have been canceled. Newly added claims 28-53 are currently pending in this application.

The following remarks put the pending claims in condition for allowance. Applicants respectfully request reconsideration and the timely allowance of the pending claims. A favorable action is awaited.

#### **Rejections under 35 U.S.C. 103(a) in parent application**

In parent application 10/040,679 the Examiner maintained a rejection of all pending claims as being allegedly unpatentable over Bussani (EP 415417) in view of Paschal (U.S. Patent No. 5,782,045) and Olsen (U.S. Patent No. 2,706,646).

The Examiner contends that Bussani teaches each and every element of the claimed invention except a quick connect member. The Examiner also asserts that this deficiency is cured by the teaching of Paschal of an advantage of a quick connect member and the teaching of Olsen of the specifics of a quick connect member. Applicant respectfully disagrees.

The claims of parent application 10/040,679 and of the present application are directed to, *inter alia*, a surgical arm system for holding surgical instruments comprising pneumatically actuated joints made with quick connect mechanisms. Bussani describes a device for holding surgical instruments with pneumatically actuated joints that are not made with quick connect mechanisms. Paschal describes using a quick connect mechanism for use in connecting standard air hoses to dental instruments. Paschal in no way teaches or suggests the use of quick connect members in load bearing application as is required by the instant invention. Olson teaches a particular quick connect mechanism for fluid hose connections. Taken together these reference do not teach the used of quick connect mechanisms as they are used in the instant invention. Clearly, the combined teaching of Bussani, Paschal and Olsen do not teach, or even suggest, each and every element of the claimed invention. At best, the combined references teach the use of quick connect mechanisms to attach an instrument to an air hose, not as a integral, load bearing portion of a surgical arm system for holding surgical instruments.

Even if the combined references did teach each and every element of the instant invention, which they do not, there is no motivation for one of ordinary skill in the art to combine Bussani, Paschal and Olsen. In order to maintain an obviousness rejection the Examiner must show that the combined teachings of the prior art render the claimed invention obvious at the time the invention was made. The claimed invention as a whole, not just its individual elements must be considered. The claims of the instant application contain many of the elements disclosed in the cited references. However, the combined teachings of these references do not make the invention, as a whole, obvious. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied upon as evidence of obviousness. See, e.g. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). Even when the level of skill in the art is high, the principle, known to one of ordinary skill, that suggests the claimed combination must be identified. In other words, the Examiner must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). The Examiner has culled a single statement from Paschal to support the combination of the cited references. This statement is not at all directed to a surgical arm support, it is directed to the connection of dental instruments directly to tubing that provides the pneumatic pressure needed to operate the dental equipment. There is no mention of a surgical arm system, or of any surgical instrument for that matter, anywhere in the disclosure of Paschal. At most, this is a suggestion to use quick connect mechanisms to directly connect dental equipment to the tubing that provides pneumatic pressure to dental instruments such as drills, vacuums and air-water syringes (column 5, lines 4-18). Therefore, it is respectfully submitted that the cited references do not provide sufficient teaching or disclosure to support the combination relied on by the Examiner for the obviousness rejection. There is no disclosure or suggestion in the references of the claimed combination to support the combination created by the Examiner. Further, it is respectfully submitted that the references relied on by the Examiner to cure the

deficiencies of the Bussani reference are not analogous to the field of the instant invention.

In order to rely on a reference as a basis for rejection of an Applicant's invention, the reference must either be in the field of Applicant's invention or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). The Examiner has relied on the combination of Paschal and Olsen in order to cure the deficiencies of Bussani. Paschal is directed to a "dental treatment unit". This "unit" is tantamount to a dentist office. Clearly, a dentist office is not analogous to a surgical arm support system. One of ordinary skill in the art would not look to such a disclosure in order to solve the problems that the present invention solves. As such, Paschal is non-analogous art and should not be applied to the instant claims.

Given that the combined teachings of Bussani, Paschal, and Olsen do not contain each and every element of the claimed invention, there is no motivation to combine these references, and that the Paschal reference is non-analogous to the present invention, Applicant respectfully asserts that the rejection under 35 U.S.C. § 103(a) as applied in parent application 10/040,679 should not be applied to the claims of the present application.

**CONCLUSION**

As all of the outstanding rejections in parent application 10/040,679 have been addressed and all of the claims are believed to be in condition for allowance, the Applicants respectfully request a Notice of Allowability. The Examiner is invited to contact the undersigned representative should any further issues arise.

Respectfully submitted,

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